

## REMARKS

Claims 6-13, 16-24, 26-29 and 31-35 are pending in the present application. By this Amendment, previously presented claim 25 is canceled; previously presented claims 6, 12, 20, 26, 28 and 32 are amended; and new claims 33-35 are added. Applicant respectfully requests reconsideration of the present claims in view of the foregoing amendment and the following remarks.

### I. Formal Matters:

#### Claim Rejection Under 35 U.S.C. §112, First Paragraph

Claims 18, 29 and 31 are rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, Examiner Johnstone is of the opinion that claims 18 and 29 contain new matter due to the claim language that describes the dimensionally stable film as having “a substantially smooth, paint-receptive surface comprising a thermosetting epoxy-polyester blend.” Applicant disagrees.

On page 3, lines 14-18 of the November 16, 2004 Office Action, Examiner Johnstone states

In claims 18 and 29 applicants recite that the substantially smooth, paint-receptive surface of the dimensionally stable film comprises “a thermosetting epoxy-polyester blend”, however the original disclosure only supports the substantially smooth, paint-receptive surface of the dimensionally stable film comprising -- a thermosetting epoxy-polyester blend film -- (specification p. 30 lines 8-12).

Applicant points to at least the following portions of the original specification for support of the claim language: page 14, lines 11-25 and page 23, lines 9-23 (discloses epoxy-polyester blends for forming a melt-flowable composition); page 26, line 23 to page 27, line 10 (discloses suitable and preferred dimensionally stable films including dimensionally stable films formed from the above-described epoxy-polyester blends used to form the melt-flowable composition, see, in particular, page 27, lines 3-7); page 29, lines 17-20 (discloses a dimensionally stable polyester film having a coating thereon, wherein the coating is an epoxy-polyester blend); Example 25, page 46 (discloses a dimensionally stable film of a cross-linked epoxy-polyester blend over a polyester melt-flowable layer); and Example 47, pages 52-53

Amendment And Response  
Serial No. 08/421,055

(discloses a dimensionally stable film of polyester having a coating thereon, wherein the coating comprises a radiation curable epoxy-polyester blend, and on the opposite surface of the polyester film, an epoxy-polyester blend melt-flowable layer).

It is respectfully submitted that the original specification provides support for (i) a dimensionally stable film formed from an epoxy-polyester blend, and (ii) a dimensionally stable film having a coating thereon, wherein the coating comprises an epoxy-polyester blend.

For at least the reasons given above, Applicant respectfully submits that claims 18, 29 and 31 meet the requirements of 35 U.S.C. §112, first paragraph, and do not introduce new matter into the original specification. Accordingly, withdrawal of this rejection is respectfully requested.

Claim Rejections Under 35 U.S.C. §112, Second Paragraph

Claims 18, 20, 29 and 31 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. On page 4, lines 6-10 of the November 16, 2004 Office Action, Examiner Johnstone states

See the new matter rejection in paragraph 4 above concerning the antecedent basis problems with the substantially smooth, paint-receptive surface of the dimensionally stable film comprising "a thermosetting epoxy-polyester blend" in claims 18, 29, and 31 (in the instant claim language it is not clear that the thermosetting epoxy-polyester blend is present in addition to the material of the dimensionally stable film).

Applicant respectfully submits that there are no antecedent basis problems in any of claims 18, 20, 29 and 31. Further, as noted above, the original specification provides support for (i) a dimensionally stable film formed from an epoxy-polyester blend, as well as (ii) a dimensionally stable film having a coating thereon, wherein the coating comprises an epoxy-polyester blend. Applicant respectfully submits that claims 18, 29, and 31 encompass both of these embodiments.

On page 4, lines 10-15 of the November 16, 2004 Office Action, Examiner Johnstone states

Amendment And Response  
Serial No. 08/421,055

Also, in claims 29 and 31 the term “paint-receptive” is meaningless without the positive step of applying paint to the paint-receptive surface as in claims 17 and 27 because there is no definition in the specification for what makes a surface “paint-receptive” other than actually receiving paint (any surface is capable of “receiving” paint, there being no requirement that paint would adhere to the surface to any particular degree once applied to the surface).

Applicant disagrees. The term “paint-receptive” means that the surface is capable of receiving paint, as well as providing a surface on which the paint will adhere. As noted in Applicant’s original specification, some dimensionally stable films must be modified in order to improve the paint-receptiveness of the film. See, for example, page 28, lines 7-8, which discloses films having additives therein to improve or impart paint adhesion properties to the film. See also, page 30, lines 4-7, which discloses surface treatments to improve adhesion of paint to a given film, such as in the case of a polyolefin film. Other dimensionally stable film possess a film composition or a coating thereon, which readily accepts paint such as paint used in the automobile industry. See, for example, page 30, lines 8-12, which discloses films of ethylene vinyl alcohol and an epoxy polyester blend applied onto a dimensionally stable film to provide a surface that readily accepts paint.

Applicant respectfully submits that the term “paint-receptive” has an acceptable and understood meaning in the art as is evident by the issuance of at least 22 U.S. patents that include the term “paint-receptive.”

On page 4, lines 15-18 of the November 16, 2004 Office Action, Examiner Johnstone states

Finally, in claim 20 it is not clear what is required by the step of bonding a “component” to the surface of the film; for purposes of this examination this language will be interpreted as bonding anything to the surface of the film, including paint or another decorative layer, but clarification is required.

Applicant respectfully submits that Examiner Johnstone’s interpretation of claim 20 is correct. The step of “bonding a component to said bondable surface of said film” encompasses any method step that bonds any component to the bondable surface of the dimensionally stable film. As disclosed in the original specification, exemplary bonding steps

Amendment And Response  
Serial No. 08/421,055

that bond a component to the bondable surface of a dimensionally stable film include (1) bonding a second film or a coating onto the bondable surface of a dimensionally stable film (page 29, lines 17-28), and (2) applying paint or primer to the bondable surface of a dimensionally stable film (page 30, lines 4-5).

For at least the reasons given above, Applicant respectfully submits that claims 18, 20, 29 and 31 meet the definiteness requirements of 35 U.S.C. §112, second paragraph. Accordingly, withdrawal of this rejection is respectfully requested.

**II. Prior Art Rejections:**

**Claim Rejections Under 35 U.S.C. §102(b)**

Previously presented claims 6-7, 16 and 21-24 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 2,061,678 to Scott (hereinafter, "Scott") or U.S. Patent No. 3,697,369 to Amberg et al. (hereinafter, "Amberg").

Previously presented claims 6-7, 12-13, 16 and 21-24 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Defensive Publication No. T867,006 to Kaul (hereinafter, "Kaul") or U.S. Patent No. 3,013,919 to Bialy (hereinafter, "Bialy").

Previously presented claims 6, 8, 16 and 21-24 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 2,647,849 to Douglas et al. (hereinafter, "Douglas").

Previously presented claims 6, 8, 16 and 20-24 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 2,789,155 to Marshall et al. (hereinafter, "Marshall").

Previously presented claims 6, 8-9, 16 and 21-24 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,126,188 to Shimizu et al. (hereinafter, "Shimizu").

Previously presented claims 6-8, 16-17 and 20-24 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 2,739,919 to Artzt (hereinafter, "Artzt").

Previously presented claims 6-7, 16 and 32 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 2,631,947 to Kline et al. (hereinafter, "Kline").

Amendment And Response  
Serial No. 08/421,055

Previously presented claims 6-8, 12-13, 16, 20-24 and 32 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,568,602 to Stow (hereinafter, "Stow").

All of the above rejections under 35 U.S.C. §102 are respectfully traversed for at least the following reasons.

In order for any one of the disclosures of Scott, Amberg, Kaul, Bialy, Douglas, Marshall, Shimizu, Artzt, Kline, or Stow to anticipate Applicant's claimed invention as embodied in independent claim 6, the disclosure of Scott, Amberg, Kaul, Bialy, Douglas, Marshall, Shimizu, Artzt, Kline, or Stow must disclose each and every claim feature recited in independent claim 6.

Each of the disclosures of Scott, Amberg, Kaul, Bialy, Douglas, Marshall, Shimizu, Artzt, Kline, and Stow fails to teach or suggest one or more claim features recited in amended independent claim 6 shown above. Accordingly, each of the disclosures of Scott, Amberg, Kaul, Bialy, Douglas, Marshall, Shimizu, Artzt, Kline, and Stow cannot anticipate Applicant's claimed invention as embodied in amended independent claim 6. Since claims 7-9, 12-13, 16, 20-24 and 32 depend from independent claim 6, and recite additional claim features, each of the disclosures of Scott, Amberg, Kaul, Bialy, Douglas, Marshall, Shimizu, Artzt, Kline, and Stow cannot anticipate Applicant's claimed invention as embodied in dependent claim 7-9, 12-13, 16, 20-24 and 32. Accordingly, withdrawal of all of the above rejections under 35 U.S.C. §102 is respectfully requested.

Claim Rejections Under 35 U.S.C. §103(a)

Previously presented claims 6-7, 16 and 21-24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Scott or Amberg.

Previously presented claims 6-7, 12-13, 16 and 21-24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kaul or Bialy.

Previously presented claims 6, 8, 16 and 21-24 were rejected under 35 U.S.C. Douglas.

Previously presented claims 6, 8, 16 and 20-24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Marshall.

Amendment And Response  
Serial No. 08/421,055

Previously presented claims 6, 8-9, 16, 21-24 and 28 were rejected under 35 U.S.C. §103(a) as being unpatentable over Shimizu.

Previously presented claims 6-8, 16-17 and 20-24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Artzt.

Previously presented claims 6-7, 16, 21-24 and 32 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kline.

Previously presented claims 6-8, 12-13, 16, 20-24 and 32 were rejected under 35 U.S.C. §103(a) as being unpatentable over Stow.

Previously presented claims 10-11 were rejected under 35 U.S.C. §103(a) as being unpatentable over (i) Kaul or Bialy or Artzt, further in view of (ii) U.S. Patent No. 4,877,679 to Leatherman et al. (hereinafter, "Leatherman1") and (iii) U.S. Patent No. 4,892,779 to Leatherman et al. (hereinafter, "Leatherman2").

Previously presented claims 18-19 and 29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Artzt, further in view of "the admitted prior art."

Previously presented claims 6, 8, 16-17, 20 and 25-27 were rejected under 35 U.S.C. §103(a) as being unpatentable over (i) Japanese Patent Application 1-152049A in view of (ii) Shimizu and (iii) U.S. Patent No. 5,162,149 to Reaney (hereinafter, "Reaney").

Previously presented claims 18-19, 29 and 31 were rejected under 35 U.S.C. §103(a) as being unpatentable over (i) Japanese Patent Application 1-152049A in view of (ii) Shimizu and (iii) Reaney, and further in view of (iv) "the admitted prior art."

Previously presented claims 9 and 12-13 were rejected under 35 U.S.C. §103(a) as being unpatentable over (i) Japanese Patent Application 1-152049A in view of (ii) Shimizu and (iii) Reaney, and further in view of (iv) U.S. Patent No. 4,822,683 to Schappert et al. (hereinafter, "Schappert").

All of the above rejections under 35 U.S.C. §103(a) are respectfully traversed for at least the following reasons.

Rejection of Previously Presented Independent Claim 6 and Its Dependent Claims:

As noted above, each of the teachings of Scott, Amberg, Kaul, Bialy, Douglas,

Amendment And Response  
Serial No. 08/421,055

Marshall, Shimizu, Artzt, Kline, and Stow fails to teach or suggest one or more claim features recited in amended independent claim 6. These references have nothing to do with a method for modifying the surface of a step joint in a vehicle body.

It should be further noted that each of the teachings of Leatherman1, Leatherman2, Reaney, and Schappert fails to teach or suggest one or more claim features recited in amended independent claim 6. Like the teachings of Scott, Amberg, Kaul, Bialy, Douglas, Marshall, Shimizu, Artzt, Kline, and Stow, these additional references have nothing to do with a method for modifying the surface of a step joint in a vehicle body.

Rejection of Previously Presented Independent Claim 28:

Regarding the rejection of claim 28 under 35 U.S.C. §103(a) as being unpatentable over Shimizu, Applicant respectfully submits that the teaching of Shimizu fails to make obvious Applicant's claimed invention as embodied in independent claim 28 for at least the following reasons.

The teaching of Shimizu is directed to shaped materials for use in sealing electronic parts, such as switches, relays, potentiometers, transformers, capacitors, sensors, integrated circuit board components, etc. The disclosed shaped materials comprise an upper film layer and a melt-flowable layer on a lower surface of the film layer.

The teaching of Shimizu fails to teach or suggest a method for modifying the surface of a vehicle, and especially, a method for modifying the surface of a vehicle comprising any one of the method steps recited in independent claim 28. Accordingly, withdrawal of this rejection is respectfully requested.

Rejection of Previously Presented Independent Claim 29 and Its Dependent Claims:

Regarding the rejection of claim 29 under 35 U.S.C. §103(a) as being unpatentable over (1) Artzt, further in view of "the admitted prior art," or (2) Japanese Patent Application 1-152049A in view of Shimizu, Reaney, and "the admitted prior art," Applicant respectfully submits that both rejections are improper and should be withdrawn for at least the following reasons.

Amendment And Response  
Serial No. 08/421,055

Each of the teachings of Artzt, Japanese Patent Application 1-152049A, Shimizu and Reaney fails to teach or suggest a film (or dimensionally stable film) comprising a substantially smooth, paint-receptive surface comprising a thermosetting epoxy-polyester blend as recited in claim 29. Further, each of the teachings of Artzt, Japanese Patent Application 1-152049A, Shimizu and Reaney fails to teach or suggest a method for modifying the surface of a substrate using such a film in combination with a melt-flowable composition.

Examiner Johnstone relies on a portion of Applicant's own original specification in order to form the basis on both rejections under 35 U.S.C. §103(a). On page 19, paragraph 27 of the November 16, 2004 Office Action, Examiner Johnstone states that page 30, lines 8-12 of Applicant's original specification is "admitted prior art." Applicant disagrees.

Page 30, lines 8-12 of Applicant's original specification discloses a dimensionally stable film having an outer surface that readily accepts paints or primers used in the automobile industry. There is nothing in this portion of Applicant's original specification that comes close to being an admission that "a film comprising a substantially smooth, paint-receptive surface comprising a thermosetting epoxy-polyester blend" was known prior to Applicant's invention.

The only suggestion and/or motivation for using "a film comprising a substantially smooth, paint-receptive surface comprising a thermosetting epoxy-polyester blend" in any of the articles or methods disclosed in the teachings of Artzt, Japanese Patent Application 1-152049A, Shimizu and Reaney is found in Applicant's own invention. Such a use of Applicant's own original specification to formulate an obviousness-type rejection is improper.

For at least the reasons given above, Applicant respectfully submits that Examiner Johnstone has failed to make a *prima facie* case of obviousness based on the combination of (i) any combination of the teachings of Artzt, Japanese Patent Application 1-152049A, Shimizu and Reaney, and (ii) Applicant's alleged "admitted prior art." There is no suggestion or motivation to combine select features of the above-described references as suggested by Examiner Johnstone other than the description of Applicant's own invention. Accordingly, withdrawal of these rejections based on Applicant's alleged "admitted prior art" is respectfully requested.

Amendment And Response  
Serial No. 08/421,055

**III. New Claims 33-35:**

New claims 33-35 are directed to further embodiments of Applicant's claimed invention as discussed above. Applicant submits that new claims 33-35 are patentable over the art of record for at least the reasons given above.

Support for new claims 33-35 may be found in Applicant's original specification in at least the following locations: page 7, lines 23-26, page 9, line 25 to page 10, line 2, page 38, lines 9-16, and Figs. 1a, 1b, 3b and 3c (claims 33-35).

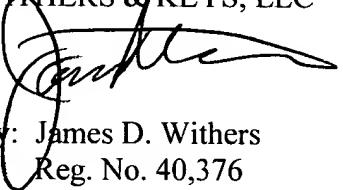
**IV. Conclusion:**

For at least the reasons given above, Applicant respectfully submits that claims 6-13, 16-24, 26-29 and 31-35 define patentable subject matter. Accordingly, Applicant respectfully requests allowance of these claims.

No additional fees are believed due; however, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 503025.

Should Examiner Johnstone believe that anything further is necessary to place the application in better condition for allowance, Examiner Johnstone is respectfully requested to contact Applicant's representative at the telephone number listed below.

Respectfully submitted,  
WITHERS & KEYS, LLC

  
By: James D. Withers  
Reg. No. 40,376

WITHERS & KEYS, LLC  
18 Atlanta Street  
McDonough, Georgia 30253  
678-565-4748

Attorney No. 10002.0098US01

3M Docket No.: 49286US003